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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/491,703
Filing Date: January 26, 2000
Appellant(s): POON, ALEX DAI-SHUN

Schwegman, Lundberg & Woessner, P.A.
Minneapolis, MN
For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief filed January 2, 2013 appealing from the Office

Action mailed on June 29, 2012.

The request for an extension of time under 37 CFR 1.136(b) for filing the Appeal Brief under 37 CFR 41.37 filed on 2 JANUARY 2013 has been **approved** for a one-month extension from the Notice of Appeal filed on 1 October 2012.

(1) Grounds of Rejection to be Reviewed on Appeal

The ground(s) of rejection set forth in the Office Action dated 29 JUNE 2012 from which the appeal is taken have been modified by the Advisory Action (Form 303) dated 25 OCTOBER 2012, in which the previous Claim Objections were withdrawn by the Examiner based on Claim Amendments filed on 1 October 2012 by the Appellant. A list of rejections withdrawn by the examiner (if any) is included under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1.) Determining the scope and contents of the prior art.
- 2.) Ascertaining the differences between the prior art and the claims at issue.
- 3.) Resolving the level of ordinary skill in the pertinent art.
- 4.) Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 9, 14, 15, 25, 30, 31, 41, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,397,221 issued to Greef et al. (hereinafter "Greef") in view of the Official Notice taken by the Examiner for a transaction to take place.

With respect to Claims 9, 25 and 41: Greef discloses, Providing a plurality of category entries to be displayed in a display window, said plurality of category entries being indicative of a categorization of a plurality of items that are available to be included in a computerized transaction (col.7, line 35) (**Greef discloses "As also noted, Web site ~~sales~~ facilities (e-commerce) are commonly built upon computer-based catalogs, which are themselves built upon product databases containing records concerning the items being offered, the term "product" embracing goods and or services. Accordingly, before any ~~transaction~~ of commercial interest can occur, Web ~~shoppers~~ must first search through such product databases in the hope of finding something of interest. Regrettably, however, at many Web sites, ~~shoppers~~ have to plow through stacks of menus and**

product information listings to find, if at all, things they might be looking for."

(col.7, 31-37). (col. 15, lines 34-52); detecting a selection of a category entry of said plurality of category entries in said display window (col. 15, lines 53-65); in response to said detection of said selection of said category entry, providing a plurality of subcategory entries to be displayed in said display window, said plurality of subcategory entries being further indicative of said categorization of said plurality of items (Greef discloses "As an alternative to relational databases, however, it has been found that even **shoppers** having different product familiarity and backgrounds are commonly able to easily and quickly extract desired product information from database that are **hierarchically** arranged and presented. As an illustration, where a **shopper** is looking for specialty apples; for example, from a gourmet site, he can more readily make progress with his **selection** if he looks first at foods, then fruits, and then apples as he progress to his **selection**. At the least, the approach of moving from generally understood category to subcategory and sub-subcategory avoids the risk of causing the uninitiated **shopper** to mistakenly compare apples and oranges when trying to make his purchase **selection**. (Greef: col.2, 61-67 and col.3, 1-6)). Here, there is "responding to said detection of said selection of said category" by having the selected product extracted from the selectable list of products. Furthermore, there clearly is "at least one subcategory field within said display window" and "plurality of subcategory entries being used to categorize said item in said transaction") Greef (col.2, 61-67

and col.3, 1-6) (col. 7, lines 31-44, col. 29, line 40-col. 30, line 60 and col. 31, lines 18-59);

detecting a selection of a subcategory entry of said plurality of subcategory entries in said display window (col.29, 8-24; col.30, 26-41; col.31, 17-50; fig's 8-14) receiving a specification of a category number (model number) that uniquely identifies a combination of said category entry and said subcategory entry (presentation format). **(Greef clearly discloses category number (model number) to be displayed for user in display window (presentation formats). Greef discloses “In preferred form, the record identifier could be selected to be, for example, the tabular attribute model number, the model number for the product being an identifier likely to receive recognition across presentation formats.”** (col.18, lines 42-46)), (col.27, 44-59, col.2, 61-67, col.3, 1-6), (col.29, 50-67; col.30, 1-14 and 25-42; col.31, 18-50). Greef discloses mapping specification as in --- “the mapping specification should be saved for use in importing tabular product data to the database in the future. If the user indicates the mapping specification is to be saved, the method enables program flow to advance over branch 272 to general step 118 for saving the mapping data.” (col.20, L24-52; col.28, L26-42)

receiving an additional specification of said category number; and based on said receiving of said additional specification of said category number automatically reselecting said category and said subcategory in said display window (col.29, 8-24; col.30, 26-41; col.31, 17-50; fig's 8-14; col.11, 47-57; col.5, 16-32). Greef discloses attribute values and “other attributes” that are same as claimed ‘additional specification’

as in --- "in view of the inclusion in table 400 of the various other attributes for the respective products in combination with the respective category and subcategory attributes, the data also includes sufficient information from which it might also be possible to establish the respective frame attributes and attribute values for the product frames of the hierarchical structure without intervention of the user." (col. 28, L54 to col. 29, L24). However, Greef might not expressly disclose a transaction, since this is an e-commerce shopping system and method, a transaction is obviously present. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a transaction take place per the Official Notice in view of Greef's teachings of an e-commerce shopping method and system and to modify in Greef because such a modification would allow Greef to have items to select from, prior to making a transaction.

With respect to Claims 14, 30 and 46: Greef discloses, wherein said plurality of category fields are to be displayed in a first portion of said display window and said plurality of subcategory fields are to be displayed in a second portion of said display window (col. 10, line 31-col. 11, line 46).

With respect to Claims 15, 31 and 47: Greef discloses, wherein said first portion of said display window is substantially adjacent to said second portion of said display window (Figure 5).

Claims 16, 32, 48, 71, 73, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,397,221 issued to Greef et al. (hereinafter "Greef") in view of Pub. No. US 2005/ 0071251A1 filed by Linden et al. (hereinafter "Linden").

With respect to Claims 16, 32 and 48: Greef failed to disclose wherein said first portion of said display window is a category field that corresponds to a page mark-up language document. Examiner notes that HTML is old and well known in the art of the internet and reference can be made to page 3, col. 1 [0035] to Linden et al. (US 2005/ 0071251A1).

With respect to Claims 71, 73 and 75: Greef discloses, wherein said plurality of category entries and said plurality of subcategory entries are to be concurrently in said display window. (col. 8, lines 26-53 and col. 29, line 39-col. 30, line 59). Examiner notes that Linden also teaches about category and subcategories.

(2) Response to Argument

Appellant's remarks and arguments with respect to the rejection of amended Claims 9, 14-16, 25, 30-32, 41, 46-48, 71, 73 and 75 have been carefully considered, but they are not persuasive. Thus, the rejection of amended Claims 9, 14-16, 25, 30-32, 41, 46-48, 71, 73 and 75 under 35 USC 103(a) is being maintained with some modifications in this Office Action, where needed to provide clarification. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Examiner notes that in response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, the Appellant is informed that the references cited in the rejection of claims must be read in entirety as other passages and drawings may also apply.

In response to the Appellant's 'amendments to the claims' and arguments against 35 USC 103 rejection, Examiner notes that when combining references for rejection under 35 USC 103, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to the Appellant's argument #1 on pages 11--12 filed on 01/02/2013 that: {"Greef does not teach or suggest "receiving a specification of a category number that uniquely identifies a combination of [a] category entry and [a] subcategory entry," much less "receiving an additional specification of said category number," and "based on said receiving of said additional specification of said category number automatically reselecting said category and subcategory in said display window," as recited in each of

independent claims 9, 25, and 41."}, and Examiner notes that Greef at least discloses as follows ---

Greef teaches mapping specification as in --- "the mapping specification should be saved for use in importing tabular product data to the database in the future. If the user indicates the mapping specification is to be saved, the method enables program flow to advance over branch 272 to general step 118 for saving the mapping data."

(col.20, L24--52; col.28, L26--42)

Additionally, Examiner notes that Greef also teaches about attribute values and "other attributes" that are same as claimed 'additional specification' as in --- "in view of the inclusion in table 400 of the various other attributes for the respective products in combination with the respective category and subcategory attributes, the data also includes sufficient information from which it might also be possible to establish the respective frame attributes and attribute values for the product frames of the hierarchical structure without intervention of the user." (col. 28, L 54 to col. 29, L 24).

Examiner notes that in Kansas Jack, Inc. v. Kuhn, 719 F.2d 1144, 1149, 219 USPQ 857, 860 (Fed.Cir.1983), it states --- 'where teachings relied upon to show obviousness were repeated in a number of references, the conclusion of obviousness was strengthened', and some of the limitations are taught in both references Greef and Linden as cited above in the 35 USC 103(a) rejection section.

In response to the Appellant's argument #2 on pages 12--13 of its Appeal Brief filed on 01/02/2013, Examiner notes that the Appellant has failed to recognize the findings of

fact already concluded by the BAPI in its decision mailed out on 09/27/2011 in this matter on pages 6-8 as follows {in curly brackets} and may have ---

{"We have reviewed col. 2, 11. 61-67 and col. 3, 11. 1-6. The passage is reproduced below:

As an alternative to relational databases, however, it has been found that even shoppers having different product familiarity and backgrounds are commonly able to easily and quickly extract desired product information from database that are hierarchically arranged and presented. As an illustration, where a shopper is looking for specialty apples; for example, from a gourmet site, he can more readily make progress with his selection if he looks first at foods, then fruits, and then apples as he progress to his selection. At the least, the approach of moving from generally understood category to subcategory and sub-subcategory avoids the risk of causing the uninitiated shopper to mistakenly compare apples and oranges when trying to make his purchase selection. The passage describes shoppers extracting product information from a database (cf. claim 9: "responding to said detection of said selection of said category entry) that are hierarchically arranged and presented (cf. claim 9: "providing a plurality of subcategory entries being hierarchically related to said selected category entry within a category hierarchy data structure.") The passage then goes on to illustrate how a shopper may look for specialty apples on a gourmet site by "moving from generally understood category to subcategory and sub-subcategory avoids the risk of causing the uninitiated shopper to mistakenly compare apples and oranges when trying to make his purchase selection" (ibid.) (cf. claim 9: "to be hierarchically displayed for said user in at least one subcategory field within said display window, concurrently with said category field, said plurality of subcategory entries being used to categorize said item in said transaction.")

Based on our review of this passage, we find that the Examiner correctly characterized the scope and content of Greef in finding that it discloses the claim limitation "responding to said detection of said selection of said category entry, providing a plurality of subcategory entries being hierarchically related to said selected category entry within a category hierarchy data structure, to be hierarchically displayed for said user in at least one subcategory field within said display window, concurrently with said category field, said plurality of subcategory entries being used to categorize said item in said transaction."

The Appellant also argued that Greef does not disclose the claim limitation "providing a category number associated with said selected category entry to be displayed for said user in said display window." Br. 12. The Examiner responded by directing the Appellant to col. 18, ll. 42-46. Answer 9-10. The Appellant did not reply.

We have reviewed col. 18, ll. 42-46. It states there: "In preferred form, the record identifier could be selected to be, for example, the tabular attribute model number, the model number for the product being an identifier likely to receive recognition across presentation formats."

The Examiner has taken the position that the term "category number" as used in the claim reads on Greef's "model number." Answer 9-10. In that regard, the Specification does not expressly define "category number." It can be represented by a number. See Specification 55:28-32. Thus, the claim term "category number" is reasonably broadly construed as covering a number. Greef's "model number" is also a number.

Accordingly, we see no error in the Examiner's position that the term "category number" as used in the claim reads on Greef's "model number." Given this, the passage at col. 18, ll. 40-42, describes presenting a number for recognition to "enable the user to select a tabular product attribute to act as general identifier for products in the hierarchical flame structure" and thereby discloses "providing a category number associated with said selected category entry to be displayed for said user in said display window" (claim 9) as claimed.

For the foregoing reasons, we find that the Examiner correctly characterized the scope and content of Greef in finding that it discloses the claim limitation "providing a category number associated with said selected category entry to be displayed for said user in said display window" (claim 9).

Claims 16, 32, 48, 58, 59, 62, 63, 66, 67, 71, 73, and 75 under 35 U.S.C. §103(a) as being unpatentable over Greef and Linden.

The Appellant relies on the arguments made in challenging the rejection of claims 9, 11-15, 25, 27-31, 41, and 43-47 under 35 U.S.C. § 103(a) as being unpatentable over Greef. Br. 13. Those arguments were found unpersuasive. See above. Accordingly, because we found them unpersuasive as to that rejection, we find them equally unpersuasive as to error in the rejection of claims 16, 32, 48, 58, 59, 62, 63, 66, 67, 71, 73, and 75 under 35 U.S.C. § 103(a) as being unpatentable over Greef and Linden.

DECISION

The decision of the Examiner to reject claims 9, 11-16, 25, 27-32, 41, 43-48, 58, 59, 62, 63, 66, 67, 71, 73, and 75 is affirmed.

AFFIRMED"} (emphasis added)

In response to the Appellant's argument #3 on pages 13--14 of its Appeal Brief filed on 01/02/2013, Examiner notes that the Appellant did not properly traverse the use of the Official Notice taken by the Examiner.

In response to the Appellant's argument #4 on pages 14-15 of its Appeal Brief filed on 01/02/2013, Examiner notes that the Linden et al. reference was used in response to significant claim amendments filed on 05/04/2012 as stated in the Final Rejection mailed out on 06/29/2012 on pages 7-8 as copied below {in curly brackets} ---

{"Claims 16, 32, 48, 71, 73, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,397,221 issued to Greef et al. (hereinafter "Greef") in view of Pub. No. US 2005/ 0071251A1 filed by Linden et al. (hereinafter "Linden").

With respect to Claims 16, 32 and 48: Greef failed to disclose wherein said first portion of said display window is a category field that corresponds to a page mark-up language document. Examiner notes that HTML is old and well known in the art of the internet and reference can be made to page 3, col. 1 [0035] to Linden et al. (US 2005/ 0071251A1).

With respect to Claims 71, 73 and 75: Greef discloses, wherein said plurality of category entries and said plurality of subcategory entries are to be concurrently in said display window. (col. 8, lines 26-53 and col. 29, line 39-col. 30, line 59). Examiner notes that Linden also teaches about category and subcategories."}

Examiner clarifies that underlined limitations above were "claim amendments" introduced by the Appellant in its filing of 05/04/2012.

Examiner reminds the Appellant that patents are written by and for skilled artisans; see *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) ("patents are written by and for skilled artisans"). Thus, Examiner therefore starts with a presumption that the Appellant is a skilled artisan who possess at least ordinary skill in the art. Consequently, it is the

Examiner's position that because the patent references of record are directed to those with ordinary skill in this art; these references are clear, explicit, and specific as to what they teach.

2112 [R-3] Requirements of Rejection Based on Inherency; Burden of Proof

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983).

Examiner had noted a few typographical errors in the Appellant's Remarks of 05/04/2012 as follows (and requested clarification) ---

- On page 8, second paragraph, cancelled claims should have stated "72, 74 & 76" and not "72, 72, & 76" as is now done in second line of that paragraph.
- On page 11, fourth paragraph, it states in error as --- "Appellants respectfully request that the Examiner withdraws the rejection of claims 9, 11-15, 25, 27-31, 41 and 43-47 under 35 U.S.C. § 103(a).", and Examiner notes that per the Remarks on top of page 8, it clearly states that many of claims, such as 10-13,

17-24, 26-29, etc., have been cancelled as stated therein --- "claims 1-8, 10-13, 17-24, 26-29, 33-40, 42-45, 49-70, 72, (74), & 76 are cancelled, and no claims are added;"; and Examiner notes that since many of the claims have already been cancelled by the Appellant in its 'amendments to the claims' filed on 05/04/2012, said request to withdraw rejection of such cancelled claims is moot.

- On page 11, fifth paragraph, it states in error as --- "Appellants respectfully request that the Examiner withdraws the rejection of claims 16, 32, 48, 58, 59, 62, 63, 66, 67, 71, 73 and 75 under 35 U.S.C. § 103(a).", and Examiner notes again that since many of these claims have already been cancelled by the Appellant in its 'amendments to the claims' filed on 05/04/2012 (such as 49-70 are now cancelled), said request to withdraw rejection of such cancelled claims is moot.

Examiner notes that the Appellant Did Not Respond to the above obvious errors so far as noted in the Final Office Action mailed out on 06/29/2012.

Examiner notes, that as described above, there is at least one related appeal known to the Examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal:

An Appeal Brief in this very application serial number (ASN) 09-491703 was filed on 09/08/2009, and a decision by the Board on 09/27/2011 AFFIRMED the Examiner.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Sanjeev Malhotra/

Examiner, Art Unit 3667

23 JANUARY 2013

Conferees:

/James P Trammell/

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